

### **REMARKS**

Claims 1-19 are all the claims pending in the application. By this Amendment, Applicant amends claim 2 to further clarify the invention and adds claim 20, which is clearly supported throughout the specification.

#### **I. Preliminary Matters**

Applicant thanks the Examiner for returning the initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on January 20, 2006. Applicant respectfully requests that the Examiner return an initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on February 8, 2005. Applicant thanks the Examiner for indicating acceptance of the drawing figures filed on February 8, 2005.

#### **II. Summary of the Office Action**

The Examiner objected to the specification. The Examiner rejected claims 1-7, 9-14, and 16-19 under 35 U.S.C. § 102 and claims 8 and 15 under 35 U.S.C. § 103(a).

#### **III. Objection to the Specification**

The Examiner objected to the Abstract of Disclosure for not being provided on a separate page. Applicant herein provides the Abstract on a separate page. In view of this amendment to the specification, Applicant respectfully requests the Examiner to now withdraw this objection.

#### **IV. Claim Rejections under 35 U.S.C. § 102**

Claims 1-7, 9-14 and 16-19 are rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Publication No. 2002/0104090 to Stettner (hereinafter "Stettner"). Applicant

respectfully traverses these grounds of rejections at least in view of the following exemplary comments.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. MPEP § 2131.

Of these rejected claims, only claims 1, 10, and 16 are independent. Independent claim 1 *inter alia* and in some variation recites: a user search received via the digital broadcast channel of the television network and retrieving the advertising information from said data gateway based on the user search.

That is, in an exemplary, non-limiting embodiment of the present invention, the users send user searches over a digital broadcast channel of the television network, and the response is made by retrieving advertising information from the data gateway. Advertisers make information available but the information is provided to users in response to a user search for information. The advertisers put advertising information on file (via the internet), and users pull the information by way of a search (via the digital broadcast channel of the television network). In other words, unlike the conventional techniques, where the advertisers push the advertisement information to selected users, for example, based on their personal information, in an exemplary embodiment, the user requests the needed advertising information via a pull based technique. It will be appreciated that the foregoing remarks relate to the invention in a general sense, the

remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claim mentioned above.

Stettner, on the other hand, discloses a system in which an information-available button or icon is made to be present during the viewing of an advertisement. As can be seen in Fig. 5 of Stettner, the user is forced to see an interactive advertisement (step 506). The user has not asked for this advertisement; it is just an advertisement of the type common to broadcast media. The user has not performed a user search, and the providing of the advertisement is not in response to the user search.

The point in Stettner is to improve the results of advertising by making it easy for the user to respond to the ad in front of them. Paragraph [0007] of Stettner describes how a TV ad for pizza, even when viewed by a hungry user wanting pizza, must necessarily be responded to by writing down the telephone number, calling the pizza restaurant, etc. To make responding easier, an “information-available” type button is made to be present. The user can use his TV to activate the button, thereby initiating a transaction (*see* button 404 in Fig. 4).

That is, the focus of Stettner is to push the advertising information to a user who has not asked for it. No user search is performed, and no user search is sent over the digital broadcast channel of the television network, as recited in claim 1. In other words, Stettner, just like conventional techniques, discloses a push based approach, where the advertising information is not provided/selected based on the user search. In Stettner, there is no disclosure of a user search received over the digital broadcast channel of the television network. In Stettner, there is no disclosure of responding to a user search with the requested advertising information from a data

gateway where the gateway has advertising information that can be received over the internet from the advertiser.

Accordingly, “an advertising information retriever configured to process a user search received via the digital broadcast channel of the television network, and to retrieve the advertising information from said data gateway based on the user search...,” as set forth in claim 1 is not disclosed by Stettner, which lacks having a user search and retrieving the advertising information based on the user search. For at least these exemplary reasons, claim 1 is patentably distinguishable from Stettner. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1 and its dependent claims 2-9.

Independent claim 10 recites *inter alia* “an interface unit configured to receive content information from an advertiser via an internet; a cable content generator configured to process the content information received by said advertiser interface and to generate advertising information adapted for transmission over the cable network.” That is, in an exemplary, non-limiting embodiment of the present invention, it is disclosed that the advertiser provides content information via internet and based on this information, the advertising is automatically generated and converted to a format acceptable for the cable network. Accordingly, the advertising information can easily be updated and modified by the advertiser.

Stettner discloses the user interacting with the merchant via internet (§ 32) and is not directed to how the advertising contents are generated. Stettner does not disclose or suggest an interface unit configured to receive content information from an advertiser via an internet and a cable content generator configured to process the content information received by said advertiser

interface and to generate advertising information adapted for transmission over the cable network. In short, Stettner is not related to *how* the advertisements are generated or provided.

In view of the foregoing points, Applicant respectfully submits that the subject matter of claim 10 patentably distinguishes from Stettner. Claims 11-15 are patentable at least by virtue of their dependency on claim 10.

Claim 16 recites features similar to the features argued above with respect to claims 1 and 10. Accordingly, claim 16 is patentably distinguishable from Stettner for at least analogous exemplary reasons. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 16 and its dependent claims 17-19.

V. Claim Rejections under 35 U.S.C. § 103

Claims 8 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stettner and further in view of U.S. Patent No. 5,948,061 to Merriman et al. (hereinafter “Merriman”). Applicant respectfully traverses these grounds of rejections at least in view of the following exemplary comments.

Claims 8 and 15 depend on claims 1 and 10, respectively. Applicant has already demonstrated that the disclosure of Stettner does not meet all the requirements of independent claims 1 and 10. Merriman is relied upon only for its disclosure of a report (*see* page 10 of the Office Action) and as such fails to cure the deficient disclosure of Stettner. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1 and 10. Since claims 8 and 15

depend on claims 1 and 10, respectively, they are patentable at least by virtue of their dependency.

VI. New Claim

In order to provide more varied protection, Applicant adds claim 20, which is patentable by virtue of its dependency and for additional features set forth therein.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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